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Date: October 25, 2004

To: Examiner Zinna N. Davis
Group Art Unit 1625

Company: United States Patent and Trademark Office
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Alexandria, VA 22313-1450

Fax No.: 571-273-0682

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From: Mila T. Kasan for Vincent P. Liptak, Reg. No. 53,225
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Fax No.: 650-638-6677
Telephone No.: 650-638-6464

Subject: Information Disclosure Statement
U.S. Patent Application No.: 10/602,974
Filed: June 24, 2003
Title: Sulfonated Diarylrhodamine Dyes

Case No.: 4365D4 US


No. of pages (including cover sheet): 7

Enclosures:

- 1) Information Disclosure Statement (3 pages); and
- 2) References Cited, PTO/SB/08A (3 pages)

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Case No. 4365D4

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : 10/602,974 Confirmation No.: 2003

Applicant(s) : Menchen et al.

Filed : June 24, 2003

TC/A.U. : 1625

Examiner : Zinna N. Davis

For : **SULFONATED
DIARYLRHODAMINE DYES**

Customer No. : 22896

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Type Name of Depositing Party: Mila T. Kasan

INFORMATION DISCLOSURE STATEMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants submit herewith patents, publications or other information (listed on the attached Form PTO-1449) of which they are aware, which may be material to the examination of this application and in respect of which there may be a duty to disclose in accordance with 37 CFR §1.56.

This Information Disclosure Statement:

- (a) ☐ accompanies a new patent application submitted herewith.
- (b) ☐ is filed within three months after the filing date of the application or within three months after the date of entry of the national stage of a PCT application as set forth in 37 CFR §1.491.
- (c) ☒ as far as is known to the undersigned, is filed before the mailing date of a first Office action on the merits.
- (d) ☐ as far as is known to the undersigned, is filed before the mailing date of a first Office action after the filing of a request for continued examination under § 1.114.

Appl. No. 10/602,974

- (e) ☐ is filed after the first Office Action and more than three months after the application's filing date or PCT national stage date of entry filing but, as far as is known to the undersigned, prior to the mailing date of either a final action under §1.113, a notice of allowance under §1.311, whichever occurs first, and is accompanied by either the fee (\$180) set forth in 37 CFR §1.17(p) or a certification as specified in 37 CFR §1.97(e), as checked below. Should any fee be due, the U.S. Patent and Trademark Office is hereby authorized to charge Deposit Account No. 01-2213 in the amount of \$180.00 to cover the cost of this Information Disclosure Statement. Any deficiency or overpayment should be charged or credited to this deposit account. **A duplicate of this sheet is enclosed.**
- (f) ☐ is filed after the mailing date of either a final rejection or a notice of allowance, but on or before the payment of the issue fee, and is accompanied by the fee (\$180) set forth in 37 CFR §1.17(i)(1) and a certification as specified in 37 CFR §1.97(e), as checked below. **This document is to be considered as a petition requesting consideration of the information disclosure statement.** The U.S. Patent and Trademark Office is hereby authorized to charge Deposit Account No. 01-2213 in the amount of \$180.00 to cover the cost of this Information Disclosure Statement. Any deficiency or overpayment should be charged or credited to this deposit account. **A duplicate of this sheet is enclosed.**

[If either of boxes (e) or (f) is checked above, the following "certification" under 37 CFR §1.97(e) may need to be completed.] The undersigned certifies that:

- ☐ Each item of information contained in the information disclosure statement was first cited in a communication mailed from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this information disclosure statement.
- ☐ No item of information contained in this information disclosure statement was cited in a communication mailed from a foreign patent office in a counterpart foreign application, and, to the knowledge of the undersigned after making reasonable inquiry, was known to any individual designated in 37 CFR §1.56(c) more than three months prior to the filing of this information disclosure statement.

A copy of the items on PTO/SB/08A is supplied herewith:

☐ each ☒ none ☐ only those listed below:

Those patent(s) or publication(s) listed in the attached PTO/SB/08A form are not supplied because they were previously cited by or submitted to the Office in prior application Serial No. 09/724,855, filed November 28, 2000, which is a continuation-in-part of application Serial No. 09/556,040, filed April 20, 2000, which is a divisional of application Serial No. 09/199,402.

Appl. No. 10/602,974

filed November 24, 1998, which is a divisional of application Serial No. 08/978,775, filed November 25, 1997, and relied upon in this application for an earlier filing date under 35 USC §120.

A copy of the items on PTO/SB/08A that are not United States Publications:

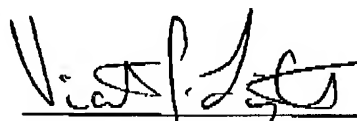
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While the information and references disclosed in this Information Disclosure Statement may be "material" pursuant to 37 CFR §1.56, it is not intended to constitute an admission that any patent, publication or other information referred to therein is "prior art" for this invention unless specifically designated as such.

In accordance with 37 CFR §1.97(g), the filing of this Information Disclosure Statement shall not be construed to mean that a search has been made or that no other material information as defined in 37 CFR §1.56(a) exists. It is submitted that the Information Disclosure Statement is in compliance with 37 CFR §1.98 and MPEP §609 and the Examiner is respectfully requested to consider the listed references.

Respectfully submitted,

Date: October 25, 2004



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Substitute for form 1449A/PTO		Complete if Known	
INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Use as many sheets as necessary)		Application Number	10/602,974
		Filing Date	June 24, 2003
		First Named Inventor	Menchen et al.
		Group Art Unit	1625
		Examiner Name	Z. Davis
Sheet	1	of	3
		Attorney Docket No.	4365D4

U.S. PATENT DOCUMENTS						
Examiner Initials*	Cite No. ¹	U.S. Patent Document		Name of Patentee or Applicant of Cited Document	Date of Publication of Cited Document MM-DD-YYYY	Pages, Columns, Lines Where Relevant Passages or Relevant Figures Appear
		Number	Kind Code* (if known)			
Zmd		5,405,975	A	Kuhn et al.	04-11-1995	
		5,434,272	A	Corrie et al.	07-18-1995	
		5,750,409		Herman et al.	05-12-1998	
		5,936,087	A	Benson et al.	08-10-1999	
		6,008,379	A	Benson et al.	12-28-1999	
		6,020,481	A	Benson et al.	02-01-2000	
		6,051,719	A	Benson et al.	04-18-2000	
		6,080,868	A	Lee et al.	06-27-2000	
		6,111,116	A	Benson et al.	08-29-2000	
		6,130,101	A	Mao et al.	10-10-2000	
Zmd		6,221,606	B1	Benson et al.	04-24-2001	
		6,248,884	B1	Lam et al.	06-19-2001	
		6,326,153	B1	Benson et al.	12-04-2001	

FOREIGN PATENT DOCUMENTS								
Examiner Initials*	Cite No. ¹	Foreign Patent Document			Name of Patentee or Applicant of Cited Document	Date of Publication of Cited Document MM-DD-YYYY	Pages, Columns, Lines Where Relevant Passages or Relevant Figures Appear	T ²
		Office ³	Number ⁴	Kind Code ⁵ (if known)				
Zmd ↓		DE	4137934	A1	Boehringer Mannheim GmbH	11-18-1991		
		EP	0 543 333	A1	Boehringer Mannheim GmbH	05-26-1993		
		WO	94/05688	A1	Applied Biosystems	03-17-1994		
		EP	0 805 190	B1	Perkin-Elmer Corp.	11-05-1997		
		EP	0 940 450	A	Perkin-Elmer Corp.	09-08-1999		
		WO	00/58406	A	The Perkin-Elmer Corp.	10-05-2000		
		WO	00/64988	A	Molecular Probes	11-02-2000		
		EP	1 054 039	A	Roche Diagnostics	11-22-2000		

Examiner Signature	Zimmerman	Date Considered	10/25/2004
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¹ Unique citation designation number. ² See attached Kinds of U.S. Patent Documents. ³ Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). ⁴ For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. * Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST.16 if possible. ⁵ Applicant is to place a check mark here if English language Translation is attached.Burden Hour Statement: This form is estimated to take 2.0 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, Patent and Trademark Office, Washington, DC 20231. DO
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		Examiner Name	Z. Davis
Sheet	2	of	3
		Attorney Docket No.	4365D4

OTHER ART - NON PATENT LITERATURE DOCUMENTS			
Examiner Initials*	Cite No.	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	T ²
gnd		Arden et al., "Fluorescence and Lasing Properties of Rhodamine Dyes," Jnl. of Luminescence 48&49:352-358 (1991)	
↑		Arden-Jacob, Jutta; Reihe Chemie; Neue langwellige Xanthen-Farbstoffe für Fluoreszenzsonden und Farbstofflaser; Verlag Shaker, pub.; Prof. Dr. K.H. Drexhage and Prof. Dr. G. von Bunau, eds.; pps. 1-169 (Dec. 12, 1992)	
		Gee et al., "Novel Derivatization of Protein Thiols With Fluorinated Fluoresceins," Tetrahedron Letters 3(44):7905-7908 (1996)	
		Haughland et al., "New Fluorescein, Rhodamine and Texa Red Analogs with Higher Fluorescence and Improved Photostability," Proceedings of the Xth International Congress, Histochemistry and Cytochemistry, pp. 273 (1996)	
		Lieberwirth et al., "Development of New Multiplex Dyes: Intramolecular Fluorescence Quenching of Rhodamine Dyes," Jnl. of Fluorescence 7(1):598-615	
		Onda et al., "Heterocycles. IV. Photolyses of the 4-Arylacetylated 1,2-Dihydroisoquinoline, Isocarbostyryl and Its Enol Acetates," Chemical and Pharmaceutical Bulletin 25(11):2935-2941 (March 12, 1977)	
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		Search Report from PCT/US01/44475 dated 05-31-2002	
		Sotomayor et al., "Bischler-Napieralski Cyclization-N/C-Alkylation Sequences for the Construction of Isoquinoline Alkaloids. Synthesis of Protoberberines and Benzo[c]phenanthridines via c-2'-Functionalized 3-Arylisoquinolines ¹ ," Journal of Organic Chemistry 61(12):4062-4072 (1996)	
		Sun et al., "Synthesis of Fluorinated Fluoresceins," J. Org. Chem. 62(19):6469-6475 (1997)	
gnd		Takai, Hideyuki, "Electrophotographic photoconductors," Chemical Abstracts 114(22):743 (June 3, 1991)	

Examiner Signature	Z. Davis	Date Considered	10/25/2004
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